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UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Donoho *et al.* Group Art Unit: 1646
Application No.: 09/733,387 Examiner: R. Li
Filed: 12/07/2000 Att Docket No.: LEX-0104-USA
Title: Novel Human Membrane Proteins and
Polynucleotides Encoding the Same

**AMENDMENT AND RESPONSE TO RESTRICTION AND ELECTION
REQUIREMENTS**

Commissioner for Patents
Arlington, VA 22202

Sir:

The Examiner is respectfully requested to enter the following amendments. A response to the Restriction and Election Requirement dated May 1, 2002 ("the Requirement") is also included herewith and the Examiner is respectfully requested to consider the remarks therein. The response is due on June 1, 2002, which falls on a Saturday and is therefore extended until Monday, June 3, 2002 under 37 C.F.R. § 1.7. Therefore, the response is timely filed, and Applicants believe no fees are due in connection with this response. However, the Commissioner is authorized to charge any required fees or credit any overpayment to Deposit Account No. 50-0892.

AMENDMENT

In the claims:

Please cancel claims 4 and 5, entirely without prejudice and without disclaimer, as drawn to non-elected inventions.

Please amend the claims so that the text of the amended claims read as follows:

1. (Amended) An isolated nucleic acid molecule comprising at least 22 contiguous bases of nucleotide sequence from SEQ ID NO:43.

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2. (Amended) An isolated nucleic acid molecule comprising a nucleotide sequence that:

- Q1
- (a) encodes the amino acid sequence shown in SEQ ID NO:44; and
 - (b) hybridizes under highly stringent conditions to the nucleotide sequence of SEQ ID NO:43 or the complement thereof.
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RESPONSE

I. Restriction Requirement

The Examiner has determined that the original claims are directed to three separate and distinct inventions under 35 U.S.C. § 121, as follows:

- Group I: Claims 1-3, said to be drawn to an isolated nucleic acid molecule of SEQ ID NO:43 or encoding the amino acid sequence set forth in SEQ ID NO:44, classified in class 536, subclass 23.5;
- Group II: Claim 4, said to be drawn to an isolated nucleic acid molecule encoding the amino acid sequence set forth in SEQ ID NO:4, classified in class 536, subclass 23.5; and
- Group III: Claim 5, said to be drawn to an isolated nucleic acid molecule encoding the amino acid sequence set forth in SEQ ID NO:34, classified in class 536, subclass 23.5.

II. Response to Restriction Requirement

In response to the Restriction Requirement mailed May 1, 2002 (Paper No. 7), Applicants hereby elect without traverse to prosecute the claims of Group I (Claims 1-3), drawn to an isolated nucleic acid molecule of SEQ ID NO:43 or encoding the amino acid sequence set forth in SEQ ID NO:44, classified in class 536, subclass 23.5. Accordingly, claims 4 and 5 are canceled as drawn to non-elected inventions. Applicants reserve the right to refile claims to the non-elected inventions in one or more future applications retaining the priority date of the present case and the earlier cited priority application.

III. Status of the Claims

Claims 4 and 5, representing the Group II and III inventions, respectively, have been canceled without prejudice or disclaimer as drawn to non-elected inventions. No claims of the Group I invention have been cancelled. Claims 1 and 2 of the Group I invention have been amended. No new claims have been added.

Claims 1-3 are presently pending in the case. For the convenience of the Examiner, a clean copy of the pending claims is attached hereto as **Exhibit A**. In compliance with 37 C.F.R. § 1.121(c)(1)(ii), a marked up copy of the original claims is attached hereto as **Exhibit B**.

IV. Support for the Amended Claims

Claim 1 has been amended to further improve its clarity, and finds support throughout the specification as originally filed, with particular support being found at least in original Claim 1.

Claim 2 has been amended to recite that the stringent hybridization conditions are highly stringent hybridization conditions. Support for this claim can be found throughout the specification as originally filed, with particular support being found at least at page 7, lines 14-20.

It will be understood that no new matter is included within the amended claims.

V. Conclusion

The present document is a complete response to the Restriction and Species Election Requirement. Applicants believe that the claims of the instant application meet all of the conditions for patentability and are in condition for allowance. Accordingly, an early indication of the same is respectfully requested. Should Examiner Li have any questions or comments, or believe that certain amendments of the claims might serve to improve their clarity, a telephone call to the undersigned Applicants' representative is earnestly solicited.

Respectfully submitted,

May 30, 2002
Date

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Exhibit A

Clean Version of The Pending Claims in U.S. Patent Application Ser. No. 09/733,387

1. (Amended) An isolated nucleic acid molecule comprising at least 22 contiguous bases of nucleotide sequence from SEQ ID NO:43.
2. (Amended) An isolated nucleic acid molecule comprising a nucleotide sequence that:
 - (a) encodes the amino acid sequence shown in SEQ ID NO:44; and
 - (b) hybridizes under highly stringent conditions to the nucleotide sequence of SEQ ID NO:43 or the complement thereof.
3. An isolated nucleic acid molecule comprising a nucleotide sequence that encodes the amino acid sequence shown in SEQ ID NO:44.

Exhibit B

Marked Up Version of Amended Claims in U.S. Patent Application Ser. No. 09/733,387

1. (Amended) An isolated nucleic acid molecule comprising at least 22 contiguous bases of nucleotide sequence [first disclosed in the NGPCR polynucleotide described in] from SEQ ID NO:43.
2. (Amended) An isolated nucleic acid molecule comprising a nucleotide sequence that:
 - (a) encodes the amino acid sequence shown in SEQ ID NO:44; and
 - (b) hybridizes under highly stringent conditions to the nucleotide sequence of SEQ ID NO:43 or the complement thereof.
3. An isolated nucleic acid molecule comprising a nucleotide sequence that encodes the amino acid sequence shown in SEQ ID NO:44.
4. (Cancelled) An isolated nucleic acid molecule comprising a nucleotide sequence that encodes the amino acid sequence shown in SEQ ID NO:4.
5. (Cancelled) An isolated nucleic acid molecule comprising a nucleotide sequence that encodes the amino acid sequence shown in SEQ ID NO:34.